

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1, 3, 5, 7, 11, 13, 16, 20, 22-23 and 28-54 are currently pending in the application. No claims have been amended, canceled or added herewith.

In the outstanding Office Action, Claims 1-3, 5-7, 11, 13, 16, 20, 22-23, 31-33, 40-45 and 49-54 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,104,711 (hereinafter “the ’711 patent”) in view of U.S. Patent No. 6,505,201 (hereinafter “the ’201 patent”) and U.S. Patent No. 6,411,615 (hereinafter “the ’615 patent”) (hereinafter collectively “the base rejection”); and the remaining claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over the base rejection and U.S. Patent No. 6,411,615 (hereinafter “the ’615 patent”) or U.S. Patent No. 6,047,060 (hereinafter “the ’060 patent”).

In response to the base rejection under 35 U.S.C. § 103(a), that rejection is respectfully traversed. Claim 1 recites obtaining “a Uniform Resource Locator stored in an address bar of a Web browser corresponding to a Web page being displayed to a user by the Web browser of the user-side”; converting, “without user intervention, the Uniform Resource Locator into a telephone number corresponding to a location at which a provider of the Web page can be contacted”; and visually identifying, “without user invention, that the telephone number is known for the Uniform Resource Locator corresponding to the Web page being displayed to the user.” The combination of such positively recited elements is not taught or suggested by the cited references.

With respect to claim 1, the Office Action admits that the ’711 patent does not teach “obtaining the name address (i.e., the URL) from an address bar of a Web browser corresponding

to a web page being displayed to a user and visually identifying that the telephone number is known for the URL corresponding to the web page being displayed to the user.” The Office Action attempts to overcome this admitted deficiency by citing not one, but two additional references, i.e., the ’201 and ’615 patents. However, (1) the Office Action has not identified a supportable basis for its assertion that the references are properly combinable and (2) the Office Action has failed to show that even if the references were combined that they would render obvious each of the positively recited elements of claim 1.

Turning to the Office Action’s motivation for the combination, it is respectfully submitted that there is no support in the art for the alleged motivation. The Office Action first cites the ’201 patent which it alleges teaches monitoring URLs in the address bar of a web browser. The Office Action then cites the ’615 patent as visually identifying information in the body of the Web document, and not information in or about the URL in the address bar. Is the Office Action alleging that in addition to the motivation to combine that there is an implicit motivation to modify one of the two additional references? No such assertion has been made, and no motivation for the modification has been identified, as would be required to make out a prima facie case of obviousness. See MPEP 2143.01. In fact, the Office Action has not identified anything in either reference that indicates that one of ordinary skill in the art would recognize any type of deficiency that needs to be corrected by the alleged combination.

Moreover, the motivation cited by the Office Action, as best as it can be understood, is contrary to the recited elements. Claim 1 recites that the obtained URL corresponds to the information displayed in the address bar, thus, there is no need to “provide an embedded IP phone module in such interactive web pages” as is described in support of the alleged “motivation.” In fact, as discussed in the previous response, it is an advantage of the claimed

system that the visual indication need not be embedded in the web page itself to avoid having to re-design existing pages that do not have space for a visual indication and/or which have not yet been re-engineered to have such a visual identification. As discussed previously, the information about whether a telephone number is known for the URL of the address bar could be managed by a third party, without the designer of the web page even knowing that such information is being provided.

The evidence in the '615 patent itself further supports that the Office Action's motivation is based on impermissible hindsight reconstruction by "glean[ing information recognized] only from applicant's disclosure." See MPEP 2145(X). The '615 patent illustrates an embodiment of its invention in Figure 3, and in that figure, as well as in its description, the inventors do not illustrate or discuss the address bar at all. Thus, if the inventors of the '615 patent did not even recognize the importance of the address bar as claimed when reading a reference which already disclosed links in the body of the web page, then there is no evidence that one of ordinary skill in the art would have recognized it either.

Applicants further note that the arguments that were presented in the previously filed response were not addressed. See MPEP 2142 requiring that "A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence." See also, MPEP 2144.08(II)(B) stating "Office personnel should consider all rebuttal arguments and evidence presented by applicants." In fact, the previous examiner indicated that he would withdraw his previous rejection based on the previous amendments, even in light of a reference that disclosed links which were embedded in the page itself – thereby acknowledging the deficiency of references such as the '615 patent.

Moreover, Applicants will rely on the fact that un rebutted advantages will be admitted as fact absent a factual basis for the position taken by the Office Action.

Furthermore, the proposed combination of references would change the principle of operation of the references, in contradiction to MPEP 2143.01. By changing from a reference that embeds the information within a web page itself to a reference that does not embed information at all but rather utilizes an address bar instead, the Office Action is suggesting a modification or combination that completely alters the principle of operation of at least one of the references (by either embedding where none existed before or worse by removing embedding that was relied on to achieve the result). The need for such a modification is persuasive evidence that the combination is not obvious.

Turning to the combination of references themselves, even if the references were combined, the combination of references still would not meet all the elements of claim 1. Claim 1 recites “visually identify, without user invention, that the telephone number is known for the Uniform Resource Locator corresponding to the Web page being displayed to the user.” However, even assuming that the ’201 patent gets a URL from an address bar, the ’615 patent does not visually identify that a telephone number is known for that URL being displayed to the user. At best the ’615 patent visually identifies that telephone numbers are known for links embedded on the web page corresponding to the URL in the address bar. This is not the same as for the URL itself as can be seen from the facts that (1) multiple telephone connections can be represented on the same page such that no telephone number corresponds to the URL and (2) the same embedded link could be on two different web pages such that telephone number corresponds to the link itself and not the URL in the address bar.

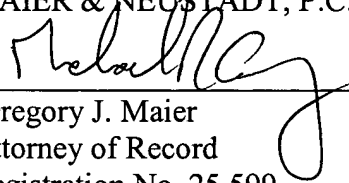
Accordingly, claim 1 is not rendered obvious by the cited combination of references, and claim 1 and its dependent claims should be indicated as allowable over the cited combination of references.

In addition, claims 5, 11, 52 and 54 recite similar limitations to the limitations of claim 1 recited above and should be indicated as patentable (along with any corresponding dependent claims) for reasons analogous to the reasons set forth for the patentability of claim 1 above.

Consequently, in view of the present amendment and in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome and the present application is now in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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